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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,836	12/07/2001	Amir G. Khan	FDN-2671	7454

7590 11/26/2003

Att: William J. Davis, Esq.
GAF MATERIALS CORPORATION
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,836

Applicant(s)

KHAN ET AL.

Examiner

Satya B Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This office Action is in response to the amendment filed on September 24, 2003. *Claim 1-20* are now pending.

Specification

2. In the amendment of the specification section on page 9, the table includes as item 3, (PA-14). This is incorrect as prior art to Vicenzi (US 4,759,799) discloses the same surfactant identified as **PA-14 acetate** (column 5, lines 1-5).

New grounds of rejection

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 1-20* are rejected under 35 U.S.C. 103(a) as being unpatentable over Grybowski et al. (US 5,004,772) in view of Davis et al. (US 5,612,141) and Vicenzi (US 4,759,799).

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The disclosure of Grzybowski et al. is in regard to asphalt roofing compositions for cold applications and based on asphalt elastomer compositions with cyclohexanone as the co-solvent. The disclosure teaches that the compositions may include **20 to 90 parts of asphalt, 1-30 parts of elastomers** based on styrene-butadiene-styrene, EPR's, EPDMs, butyl, SIS, SEBS and/or blends of these. The solvent may include any of a well-known aromatic or **aliphatic organic hydrocarbon solvents or combination thereof**, able to solvate asphalt and at least some portion of the elastomer. Typical solvents include, but are not limited to: mineral spirits, kerosene, fuel oils, gasoline, naphtha, etc. The **solvent** is utilized in an amount ranging from **0-30 parts by weight of the total composition**. The **cyclohexanone co-solvent** is utilized in an amount of from **4 to 35 parts** by weight of the total composition. For purposes of **thickening** and/or reinforcing the adhesive, inert organic and/or **inorganic fillers** known in the art may be used in an amount ranging from **0 to 30 parts** by weight of the total composition. Typical inert fillers may be **clays, calcium carbonates, talcs**, etc. **Fibers** can also be advantageously added, in an amount ranging from **0 to 20 parts** by weight of the total composition. **Fibers** well in the art can be **organic** or inorganic, e.g. asbestos, synthetics, **cellulosics** etc. Viscosity of the adhesive compositions as per ASTM D4470-85 and ASTM D5-86 are also disclosed (column 3, lines 5-68). The **mixing process** involves preferably first adding the cosolvent and elastomer to a mixer and mixing the two components, adding asphalt dissolved in mineral spirits, fuel oil, etc., adding reinforcing fibers and/or fillers etc. Variations of the preferred method are also possible. (Column 4, lines 5-28). The compositions are **useful as roofing compositions** especially adapted for **cold applications**.

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The difference between the prior art and the present invention is the inclusion of (a) 1 to 10 weight % metal silicate and (b) 0.1 to 5 wt.% of an alkoxyalkyl amine substituted ester of a C₂ to C₁₂ carboxylic acid in the adhesive composition.

The prior art to Grzybowski et al. discloses for purposes of **thickening** and/or reinforcing the adhesive, inert organic and/or **inorganic fillers known in the art** in an amount ranging from **0 to 30 parts** by weight of the total composition. Typical inert fillers may be **clays, calcium carbonates, talcs, etc. Fibers** can also be advantageously added, in an amount ranging from **0 to 20 parts** by weight of the total composition (column 4, lines 37-44). Other inorganic fillers known in the art that are functionally equivalent are disclosed in the prior art to Davis et al. This prior art discloses adhesive compositions that include inorganic fillers such as calcium carbonate, clay, silica, magnesium silicate and fine rubber particles (column 12, 7-14). The patentability of a subject matter is encompassed by the prior art unless there is an evidence indicating criticality of including magnesium silicate as opposed to clay, talc or calcium carbonate in the adhesive compositions.

The prior art to Vicenzi discloses improved asphalt roof-coating compositions of the asbestos-free type which include asphalt cutback, clay, a surfactant based on alkoxyalkylamine salt, and fillers (abstract). Working examples typically include PA-14 acetate in 1-2% by weight in the adhesive compositions. The disclosure further includes that the adhesive compositions that include such a surfactant provides for advantages such as using lower amounts than other surfactants of previous compositions, stable gel structures and easier blending (abstract). In light of such benefits, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include surfactant based on alkoxyalkylamine salt as taught by Vicenzi et

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a. and also use clay, calcium carbonate or magnesium silicate interchangeably as the inorganic reinforcing filler as taught by Davis et al. and thereby obtain the present invention. Discovery of optimum value of result effective variable in known process is ordinarily within the skill in the art and would have been obvious. *In re Boesch and Slaney* 205 USPQ 215 (CCPA 1980).

Furthermore, wherein the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine optimization. *In re Hoeschele* 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), where there were no evidence of criticality of the claimed ranges of molecular weights of the elastomeric polyurethanes, which fell within the broad scope of the references.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bresson et al. (US 4,196,115), Tomlinson et al. (US 6,543,199 B1), Algrim et al. (US 4,824,880), Hudson et al. (US 5,529,621), Krogh et al. (US 5,730,791 and 5,618,340) and Funkhouser (US 5,979,133).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (703) 305-8490.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (703) 308-2450.

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Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at (703) 308-0661.

SATYA SASTRI

November 21, 2003



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700